

Remarks

This amendment is in response to the Office Action dated July 22, 2005. Claim 9 has been amended for clarity. New claims 30-42 have been added. Claims 16-29 were previously canceled without prejudice. Claims 1-15 and 30-42 are currently pending. Reexamination and reconsideration are respectfully requested.

Applicant respectfully thanks the Examiner for indicating that claims 3, 7, and 9-15 would be allowable if rewritten in independent form including all of the limitation of the base claim and any intervening claims. Applicant has chosen to continue to assert the patentability of the base claim as discussed below, and applicant respectfully submits that claims 3, 7, and 9-15 are in patentable form.

Claims 1, 2, 4-6, and 8 were rejected under 35 U.S.C. 103(a) as unpatentable over U.S. Patent No. 5,708,540 to Ananth et al. (“Ananth”) in view of U.S. Patent No. 5,761,790 to Carr et al. (“Carr”). The rejection is respectfully traversed.

The Examiner stated that “[e]ven though the slider of Ananth et al. is made of the ceramic, it is well known in the art to use silicon material for the manufacturing the slider.” Office Action at page 3. The Examiner then apparently cited Carr to justify the above quote, stating that Carr utilizes “a silicon material in order to protect weariness as shown in Fig. 6 (also see col. 2, lines 59-62 and col. 6, lines 24-51).” Office Action at page 3.

Applicant respectfully submits that the Examiner did not meet his burden to establish a *prima facie* case of obviousness. According the MPEP section 706.02(j), to establish a *prima facie* case of obviousness, the following criteria should be met. First, there should be a suggestion or motivation in the art to modify the reference or to combine reference teachings. Second, there should be a reasonable expectation of success. Third, the reference(s) must teach all the claim limitations. MPEP section 706.02(j).

Applicant respectfully submits that the Examiner's citations are insufficient to satisfy the criteria above and accordingly, the rejection should be withdrawn. Applicant respectfully submits that one of ordinary skill in the art would not be motivated to make the combination and modification suggested by the Examiner.

Applicant does not understand that Examiner's explanation that Carr describes "using silicon to protect weariness as shown in Fig. 6." The cited sections of Carr do not appear to include such a statement, and appear to provide no guidance regarding a particular slider substrate material to use for wear resistance. Moreover, it is believed that silicon generally has a wear resistance that is less than other materials such as TiC/Al₂O₃.

In addition, applicant is unsure which trench in Carr the Examiner is referring to in the statement on page 3 of the Office Action that "Carr et al. teach a process of making a slider having at least one trench by etching (as per claim 5) with a silicon material in order to protect weariness. . ." It appears that the trenches shown in Fig. 6 are in the read/write device formed on an end 506 of the slider substrate 502 and not in the slider substrate 502 of Carr.

Applicants respectfully submit that the Examiner is using both improper hindsight and using an impermissible obvious to try rationale for rejecting the claims. As a result, one reading the Carr reference and desiring wear resistance would not appear to be motivated to use silicon as suggested by the Examiner and would have no reason to combine Ananth and Carr.

Applicant respectfully submits that for at least the above reasons, one of ordinary skill would not make the combination of references or use the rationale suggested by the Examiner. Accordingly, the rejection of claims 1, 2, 4-6, and 8 should be withdrawn.

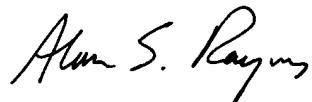
New claims 30-42 have been added. It is believed that no new matter has been entered. Support for these claims may be found throughout the specification and figures, for example, in the specification at pages 4-8 and in the original claims.

The Office Action included various comments concerning the art and the non-patentability of certain claims. Applicants respectfully disagree with the Examiner's non-patentability conclusions. Applicant also does not concede that the Examiner's characterization of the prior art is accurate. The discussion above has directly addressed some of the Examiner's comments and any of the Examiner's comments not specifically discussed above are deemed moot at this time in view of this response.

Applicant respectfully submits that the pending claims are in condition for allowance. Reexamination and reconsideration are respectfully requested. If, for any reason, the application

is not in condition for allowance, the Examiner is requested to telephone the undersigned to discuss the steps necessary to place the application into condition for allowance.

Respectfully submitted,



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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA, 22313-1450, on November 22, 2005.



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November 22, 2005
Date